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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/992,075	11/06/2001	Johann Engelhardt	5005-1009	4876

23280 7590 11/07/2003

DAVIDSON, DAVIDSON & KAPPEL, LLC  
485 SEVENTH AVENUE, 14TH FLOOR  
NEW YORK, NY 10018

EXAMINER
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FINEMAN, LEE A

ART UNIT	PAPER NUMBER
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2872

DATE MAILED: 11/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/992,075

Applicant(s)

ENGELHARDT ET AL.

Examiner

Lee Fineman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 20 August 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-8,10 and 11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-8,10 and 11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 17 January 2003 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 20 August 2003 has been entered. In it, claims 1, 2, 5, 7 and 10 were amended, claim 11 was added and claims 3 and 9 were cancelled. Claims 1-2, 4-8 and 10-11 are pending.

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-2, 4-8, 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kitagawa et al., U.S. 6,297,904 B1 in view of Carlsson et al., "Confocal Imaging for 3-D Digital Microscopy" in Applied Optics, Vol. 26(16), November 6, 1986, pp. 3232-3238.

Kitagawa et al. disclose an arrangement for visual and quantitative examinations of specimens comprising a stereomicroscope (10, fig. 12) with an objective (2), a first and second eyepiece (within the binocular part) wherein the objective and the first and second eyepiece defines a first and a second observation beam path (column 13, lines 36-38, through image surface 7, where the first observation beam path is from one eyepiece in binocular part to the

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objective and sample and the second observation beam path is from the other eyepiece in binocular part to the objective and sample), a tube lens (8) disposed in at least one of the observation beam paths, a confocal scanning device (20) connected to the stereomicroscope thereby providing a scanning beam path (through image surface 27) wherein the scanning device scans a specimen (1) through the objective (2) and acquires data for a visual depiction of the specimen (column 13, lines 59-66), an optical coupling-in element (9, column 13, lines 59-66) configured to couple the scanning beam path into as least one of the observation beam paths at a coupling-in region (fig. 12), wherein the tube lens (8) is disposed between the coupling-in region and the objective, wherein the scanning device is detachably attached to a camera port (column 12, line 66-column 13, line 5) at which the scanning device couples the scanning beam into the stereomicroscope, and wherein the confocal scanning device is mounted on the stereomicroscope (fig.12). Kitagawa et al. disclose the claimed invention except for explicitly stating that the data is for three-dimensional visual depiction of the specimen and wherein the scanning device is connected to a computer that analyses the image data acquired and displays them on a display. Carlsson et al. teaches in fig 2 acquiring data for three-dimensional visual depiction of the specimen by connecting the scanning device is to a computer (microprocessor) that analyses the image data acquired and displays them on a display (TV). It would have been obvious to one of ordinary skill in the art at the time the invention was made to add the computer and display of Carlsson et al. to the system of Kitagawa et al. to provide three-dimensional images of the specimen.

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***Response to Arguments***

4. Applicant's arguments with respect to claims 1-2, 4-8 and 10-11 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lee Fineman whose telephone number is (703) 305-5414. The examiner can normally be reached on Monday - Friday 7:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew Dunn can be reached on (703) 305-0024. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4900.



LAF

November 5, 2003



MARK A. ROBINSON  
PRIMARY EXAMINER